

No. 15,630

IN THE

United States Court of Appeals  
For the Ninth Circuit

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AMERICAN PIPE AND CONSTRUCTION Co.,  
a corporation,

*Appellant,*

vs.

SPENCER A. EARNSHAW,

*Appellee.*

REPLY BRIEF ON BEHALF OF APPELLANT  
AMERICAN PIPE AND CONSTRUCTION CO.

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**IN GENERAL.**

To simplify the issues for the Court, we find it necessary to reply briefly to the Brief On Behalf Of Appellee, Spencer A. Earnshaw.

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**APPELLEE'S ARGUMENT THAT CLAIMS 6, 7, 13 AND 14 OF LETTERS PATENT NO. 2,639,943 ARE VALID IS BASED ON PREMISES WHICH NOT ONLY ARE UNSUPPORTED BY THE EVIDENCE BUT ARE CONTRARY TO THE EVIDENCE.**

**A. Appellee's argument that the prior public knowledge and use by Lock Joint Pipe Company in 1946 of brushes or rubber rollers was established solely by "unsupported" oral testimony is contrary to the record.**

The testimony of the witness Kennison, commencing at R. 173 and continuing through R. 193, that rubber

brushes or rollers were built, installed in a Brend machine and used to commercially make commercial pipe in 1946, is fully corroborated by documentary evidence. This documentary evidence includes dated drawings (R. 342) and dated correspondence, orders and invoices (R. 343 to R. 350, inclusive). Certainly, such fully documented proof is not only satisfactory proof, but proves the fact beyond reasonable doubt and is not solely "unsupported oral testimony of one witness" as is argued by appellee. It was certainly satisfactory to the trial court because the trial Court found as follows:

"7. That during the year 1946 Lock Joint Pipe Company, of New Jersey, at their plant at East Orange, New Jersey, caused to be designed and manufactured brushes for the 'Brend' machine having an outer periphery of rubber, which rubber outer periphery was ribbed longitudinally.

8. That during the year 1946 said Lock Joint Pipe Company installed such rubber brushes in a 'Brend' machine in lieu of wire brushes and successfully coated pipe with such 'Brend' machine so fitted with rubber brushes." (R. 62 and 63.)

In view of the above, it cannot be said that these findings by the trial Court are clearly erroneous and should be set aside, and therefore appellee's argument that the patent claims in issue are not invalid because of this prior knowledge and use is without weight.

- B. Appellee's argument that the Lock Joint prior use and knowledge was "concealed and kept secret" is contrary to the evidence.

Appellee's brief erroneously states on page 17 the following:

"\* \* \* Nowhere in the testimony is there any statement by Kennison or by any one else connected with Lock Joint that the so-called experiments were not conducted in secret, that what was done was not suppressed, nor concealed. \* \* \*"

and from this erroneous statement, appellee in his brief concludes and argues as follows:

"An invention, the discovery and use of which is not made public but is concealed and kept secret, will not anticipate a patent for the same device thereafter discovered."

Appellee, in making such a statement on page 17 of his brief, must have overlooked the testimony of Adolph G. Butler appearing at R. 165 as follows:

"Q. When did you first hear of the use of the rubber rollers on the Brend machine?

A. From Hugh Kennison back along in 1946 or '47.

Q. And who is Hugh Kennison?

A. He is the chief engineer for the Lock Joint Pipe Company."

In fact, the trial Court found as follows (R. 63):

"9. That Lock Joint Pipe Company, prior to the year 1948, fully informed Defendant, American Pipe and Construction Co., of its said use of rubber brushes in a 'Brend' machine."



Clearly, the prior use and knowledge of the use of rubber brushes in a Brend machine by Lock Joint Pipe Company, as testified to by the witness Kennison, was a prior public knowledge and use and was proved beyond reasonable doubt. Therefore, appellee's argument that such use was "concealed" and "kept secret" is contrary to the evidence and finds no support in the record, and this basis of arguing that the contested claims are valid is without support.

**C. Appellee's argument that substituting rubber brushes in the Brend machine for wire brushes amounts to invention is clearly refuted by the record.**

Appellee argues at great length that rubber brushes are more enduring and wear longer than wire brushes, but he fails to argue that any different result or improved operation of the Brend machine results from the substitution of rubber brushes for wire brushes. As a matter of fact, the witness Butler, when on the stand, testified that an investigation of the merits of wire brushes versus rubber brushes, made by him after he gave his deposition (quoted by appellee in his brief), showed that there was no particular advantage in length of life in the use of rubber rollers or brushes in lieu of the wire brushes. See Butler testimony as follows (R. 148):

"Q. Now, these rubber rollers last longer than the wire, don't they?

A. No, they do not.

Q. Well, don't you get more use out of one rubber roller than you do out of one wire brush?

A. I have just completed the research since this controversy started, and I find that that is not the case."



Mr. Butler testified again at R. 158 as follows:

“A. I have it in pounds. We can put 449,000 pounds of material through before they are changed.

Q. That is the rubber?

A. That’s right.

Q. And what about the brush?

A. The Portland plant reported here just recently they put 665,000 pounds through the wire brushes.”

Certainly, the selection of the best material to decrease abrading of a rotary brush or roller is not invention, particularly in view of the record showing prior art patents employing rotors similarly coated with rubber for the same reason. See the Hamill Patent No. 2,530,767. (R. 382.) We quote the following from that patent:

“The object of the present invention is a gear-tooth pump which reduces abrasive action on the meshing surfaces; \* \* \*.”

\* \* \* \* \*

“The pumping wheels may be wholly of rubber \* \* \*.”

\* \* \* \* \*

“Where abrasive substances are present in the liquid, it is preferred to provide both wheels with the elastic or resilient provision\* to avoid a possible lapping action, but in suitable application, one wheel only may be so constructed.”

Where it is taught in an analogous art to use rubber coated counter-rotating rotors to reduce abrasion, can it possibly be considered to be patentable invention to substitute a rubber roller for a wire brush in the Brend

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\*Rubber periphery.

machine? We urge that appellee's argument that patentable invention is present is without merit.

**D. Appellee's reliance on the District Court's statement that the Earnshaw patents "have additional elements of originality" to sustain the claims in issue is likewise without merit.**

A simple reading of the claims which we contend are invalid, which are claims 6, 7, 13 and 14 of Patent No. 2,639,943, will demonstrate beyond doubt that these claims do not include anything but the substitution of rubber rollers for the wire brushes in the Brend machine. We quote claim 7 as an example:

"A machine for applying particled material of the character set forth, including a drum provided with a resilient surface, a second drum providing an opposing surface to the first drum, means for rotating the second drum, and means for feeding particled material between the surfaces of the two drums, the resilient surface of the first drum maintaining particled material against the surface of the second drum to discharge the particled material at a velocity sufficient to compact the particles of said material against a surface at a distance from the machine."

Notice that this claim covers only a pair of rotary drums having resilient surfaces and adapted to be counter-rotated as in the Brend machine. Consequently, if there are other additional elements of originality in the machine shown in this patent, they are not included within the claims which we contend are invalid. Therefore, appellee's reliance on the Court's statement as above quoted to infuse validity into these invalid claims is without merit.

APPELLEE MAKES NO ARGUMENT IN HIS BRIEF THAT THE DISTRICT COURT WAS CORRECT IN FAILING TO PASS ON THE ISSUE OF INFRINGEMENT OF ANY OF THE CLAIMS OF THE EARNSHAW PATENTS BY THE BREND MACHINE USING RUBBER ROLLERS IN LIEU OF WIRE BRUSHES.

We contend that one of the principal errors of the District Court was in failing to find, conclude and adjudge that the Brend machine, when equipped with rubber brushes in lieu of wire brushes, did not infringe any of Earnshaw's patents Nos. 2,639,942, 2,639,943, and 2,681,725. (See assignment of error 3.) We argue in our opening brief that the issue of infringement was raised by the Counterclaim and that the Court should have, under the facts found by it, granted a judgment to counterclaimant that the Brend machine, when equipped with rubber brushes in lieu of wire brushes, did not infringe any of the Earnshaw patents in suit. We argue that this issue is clearly raised and the Court should have decided it and awarded judgment in accordance with its findings. Appellee, in his brief, advances no argument to dispute this contention as far as we can determine from his brief.

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### CONCLUSION.

We submit that the District Court erred as set out in the specification of errors in our opening brief, and that the Judgment should be modified.

Dated, March 18, 1958.

Respectfully submitted,

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